

REMARKS

These remarks are responsive to the Office Action dated April 6, 2004. Currently, claims 1-40 are pending with claims 1, 9, 17, 25 and 33 being independent.

The Examiner rejected claims 1-3, 8-11, 16-19, 24-27, 32-35 and 40 under 35 U.S.C. 102(e) as being unpatentable over US Patent No. 6,252,850 to Lauret ("Lauret").

The Examiner rejected claims 6, 7, 14, 15, 22, 23, 30, 31, 38 and 39 under 35 U.S.C. 103(a) as being unpatentable over Lauret in view of U.S. patent No. 6,219,396 to Owada ("Owada").

The Examiner rejected claims 4, 12, 20, 28 and 36 under 35 U.S.C. 103(a) as being unpatentable over Lauret in view of U.S. Patent No 6,047,002 to Hartmann et al. ("Hartmann").

The Examiner objected to claims 5, 13, 21, 29 and 37 as being dependant upon a rejected base claim, but stated that they would be allowable if rewritten in independent form including all of the limitations of the base claim and intervening claims.

These objections and rejections are respectfully traversed for at least the reasons set forth below.

35 U.S.C. 102(e)

The Examiner rejected claims 1-3, 8-11, 16-19, 24-27, 32-35 and 40 under 35 U.S.C. §102(e) as being anticipated by Lauret. This rejection is respectfully traversed.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. . . . The identical invention must be shown in as complete detail as is contained in the claim." MPEP § 2131, p. 2100-70 (Rev. 1, Feb. 2003) (citations omitted).

Claim 1 of the present invention recites an apparatus for synchronizing a clock with data received via an asynchronous transmission medium. The apparatus comprises a plurality of

buffers connected to the asynchronous transmission medium; circuitry configured for reading out data from said buffers at a clock rate specified by said clock, and a *regulating circuit* configured to regulate said clock rate according to the transmission rate of said data. That is, the buffers each receive data at some unspecified rate and then the data is read out of each buffer at that clock rate (*see also* pp. 10-11).

In contrast, Lauret recites an adaptive clock recovery mechanism for an ATM receiver for *recovering* a service clock, which is the clock frequency of the source data, transmitted via an ATM network. (Lauret, col. 1, ll. 19-20; col. 2, ll. 42-45). Under the adaptive method, the service clock recovery is based on the fill-level of an incoming cell buffer. (Lauret, col. 2, ll. 19-20). Specifically, the mechanism of Lauret is for the “enables cell jitter to be filtered prior to recovery of the service clock. (Lauret, col. 2, ll. 60-64). Following the filtering, cells are then clocked from the fine buffer at substantially the service clock frequency. (Lauret, Fig. 3; col. 5, ll. 6-14, lines 45-47 and lines 57-58).

Accordingly, Lauret fails to set out each and every element as set out in Applicant’s claimed invention.. Instead, Lauret recites a jitter filter system where the rate of output from the first buffer is within a predetermined range and only the rate of cell output from the second buffer is locked substantially to the service clock frequency.

For the foregoing reasons, claim 1 is not anticipated by Lauret and the rejection is respectfully traversed.

Independent claim 9 recites a “means for synchronizing a clock using data received via an asynchronous transmission medium, comprising: a plurality of buffers connected to said asynchronous transmission medium; readout means for reading out said data from said buffers at

a rate specified by said clock, and regulating means for regulating said clock rate according to a rate of transmission of said data.”

Similarly, claim 9 is not anticipated by Lauret because each and every element as set out in Applicant’s claimed invention is not set out in Laurent. For example, Laurent does not set out an element of “regulating means for regulating said clock rate according to a rate of transmission of said data.” Rejection is respectfully traversed.

Independent claim 17 recites “[a] method of synchronizing a clock, comprising: receiving data from an asynchronous transmission medium; buffering blocks of data received from said transmission medium; reading out buffered data at a rate specified by said clock; and regulating said clock rate according to a transmission rate of said data.”

Similarly, claim 17 is not anticipated by Lauret because each and every element as set out in Applicant’s claimed invention is not set out in Laurent. For example, Laurent does not set out an element of “regulating said clock rate according to a transmission rate of said data.” Rejection is respectfully traversed.

Independent claim 25 recites “[a] PBX distributed in at least two cabinets interconnected by an asynchronous transmission medium comprising: a clock in at least one of said cabinets; a plurality of buffers in said at least one of said cabinets configured to buffer data received over said asynchronous transmission medium; wherein said clock is configured to clock said buffers; wherein a clock rate of said clock is controlled by a rate of transmission of said data.”

Similarly, claim 25 is not anticipated by Lauret because each and every element as set out in Applicant’s claimed invention is not set out in Laurent. For example, Laurent does not set out an element of a clock “wherein a clock rate of said clock is controlled by a rate of transmission of said data.” Rejection is respectfully traversed.

Independent claim 33 recites “[c]omputer programs embodied in a tangible medium for synchronizing a clock with a transmission rate of data received via an asynchronous transmission medium, comprising instructions directing an arithmetic and logic unit (ALU) to: store blocks of data received from said transmission medium in a plurality of buffers; read out said data from said buffers at a rate specified by said clock; and regulate said clock rate according to a rate of transmission of said data.”

Similarly, claim 33 is not anticipated by Lauret because each and every element as set out in Applicant's claimed invention is not set out in Laurent. For example, Laurent does not set out an element of to "regulate said clock rate according to a rate of transmission of said data."

Rejection is respectfully traversed.

Claims 2, 3, 8, 10, 11, 16, 18, 19, 24, 26, 27, 32, 34, 35 and 40 depend from claims 9, 17, 25 and 33, respectively. Thus, claims 2, 3, 8, 10, 11, 16, 18, 19, 24, 26, 27, 32, 34, 35 and 40 are not anticipated by Lauret for at least the reasons that claims 1, 9, 17, 25 and 33 are not anticipated by Lauret. The Examiner is respectfully requested to reconsider and withdraw his rejection of claims 1-3, 8-11, 16-19, 24-27, 32-35 and 40.

35 U.S.C. 103(a)

The Examiner rejected claims 6, 7, 14, 15, 22, 23, 30, 31, 38 and 39 under 35 U.S.C. 103(a) as being unpatentable over Lauret in view of U.S. patent No. 6,219,396 to Owada ("Owada"). Claims 6-7, 14-15, 22-23, 30-31 and 38-39 depend from independent claims 1, 9, 17, 25 and 33 respectively.

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." MPEP § 2143.

As discussed above, Lauret fails to contain a suggestion or motivation to combine the teachings of Owada to achieve Applicant's claimed invention.. Therefore, claims 6, 7, 14, 15, 22, 23, 30, 31, 38, are not rendered obvious by Lauret and Owada for at least the reasons discussed with respect to claims 1, 9, 17, 25 and 33.

Improper to Combine References:

The Examiner asserts that it would have been obvious to modify Lauret in view of Owada so as to arrive at the present invention. But there is no teaching or suggestion to combine the two references to achieve Applicant's claimed invention, which pertains to a "system and method for synchronizing with data received over an unreliable asynchronous medium." Both of the cited references refer to jitter reduction for clock generators. It appears the references were based, at best, on using Applicant's claimed invention as a blueprint:

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that created the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art referenced for combination in the manner claimed. *In re Rouffet*, 149 F. 3d 1350, 1357 (Fed. Cir. 1998). *See also, In re Dembiczak*, 175 F. 3d 994, 99 (Fed. Cir. 1999) ('Combining prior art references without evidence of such a suggestion, teaching or motivation [to do so] simply takes the inventor's disclosure as blueprint for piecing together the prior art to defeat patentability - the essence of [impermissible] hindsight.').

The Examiner in the present case has not proffered a motivation in the reference or otherwise to combine Lauret and Owada. Accordingly, the Examiner is respectfully requested to reconsider and withdraw his rejection of claims 6, 7, 14, 15, 22, 23, 30, 31, 38 and 39.

The Examiner rejected claims 4, 12, 20, 28 and 36 under 35 U.S.C. 103(a) as being unpatentable over Lauret in view of U.S. Patent No 6,047,002 to Hartmann et al, ("Hartmann"). Claims 4, 12, 20, 28 and 36 depend from independent claims 1, 9, 17, 25 and 33 respectively.

But Lauret fails to provide any suggestion or motivation to be combined with Hartmann to achieve Applicant's claimed invention. Hartmann does not cure the defects of Lauret. Therefore, claims 4, 12, 20, 28 and 36 could not be rendered obvious by the hypothetical combination of Laurent and Hartmann.

Improper to Combine References:

The Examiner asserted that it would have been obvious to modify Lauret in view of Hartmann so as to arrive at the present invention. However, there is no teaching or suggestion to combine the two references. Instead, Lauret and Hartmann deal with very different subject matter. Hartmann discloses a communication system which includes more efficient packet conversion and routing for improved performance and simplified operation. This is unrelated to synchronizing a clock with data received over an asynchronous medium as in Lauret.

As noted above, the burden of proof lies with the Examiner to show a motivation or suggestion to combine these references other than the present application. The Examiner in the present case has not proffered a motivation in the references or otherwise to combine Lauret and Hartmann. Thus, the Examiner is respectfully requested to reconsider and withdraw his rejection of claims 4, 12, 20, 28 and 36.

Objections

The Examiner objected to claims 5, 13, 21, 29 and 37 as being dependent upon a rejected base claim, but stated that they would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 5, 13, 21, 29 and 37 depend from claims 1, 9, 17, 25 and 33 respectively. For at least the reasons stated above, claims 1, 9, 17, 25 and 33 are not anticipated by Lauret. Thus, since the base claims are novel over the

cited art, the objections to claims 5, 13, 21, 29 and 37 are respectfully traversed and the Examiner is requested to reconsider and withdraw his objections.

Other Matter

No new matter has been added.

The claims currently presented are proper and definite. Allowance is accordingly in order and respectfully requested. However, should the Examiner deem that further clarification of the record is in order, we invite a telephone call to the Applicants' undersigned attorney to expedite further processing of the application to allowance.

Date: August 6, 2004

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Richard M. Lehrer", is written over a horizontal line.

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